

REMARKS

Applicants thank the Examiner for granting Applicants' July 1, 2003, request for a Continued Prosecution Application.

In the first Office Action on this Continued Prosecution Application, claims 1-15 were rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement of "assigning an assignable ACD to the particular user only." Applicants respectfully traverse this rejection.

Additionally, claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,850,218 to LaJoie et al. (hereinafter "LaJoie") in view of U.S. Patent No. 6,301,616 to Pal et al. (hereinafter "Pal"). Applicants respectfully traverse these rejections.

Rejections under 35 U.S.C. § 112, First Paragraph

Independent claim 1 is directed to a method of presenting an audiovisual signal to a user's audiovisual display monitor, including the steps of, *inter alia*:

- receiving a command from the user;
- responding to the command by *assigning* an assignable computing device (ACD) *to the particular user only*;
- establishing a communications link between the user's audiovisual display monitor and the ACD.

Independent claim 16 is directed to an apparatus for presenting an audiovisual signal to a user's audiovisual display monitor, and includes similar limitations.

Applicants previously amended claims 1 and 16 to further clarify that a particular ACD is assigned to a particular user and that user alone, i.e., for dedicated service to the particular user, more clearly distinguishing the cited prior art (*e.g.*, LaJoie). Applicants assert that the specification provides sufficient description of this limitation to satisfy the enablement requirement of § 112, first paragraph. (*See, e.g.*, Specification, p. NY02:470403.1

21, lines 19-21; Specification, p. 22, line 16 - p. 23, line 10, describing that after an ACD is assigned to a user, it is removed from a list of available devices). Applicants assert that this description, read in the context of known systems and methods of the prior art, is sufficient to enable one of ordinary skill in the art to practice the invention. The subject matter of the independent claims is no more limiting than the disclosure of the specification. Accordingly, Applicants respectfully request that the § 112 rejections be withdrawn.

Rejections under 35 U.S.C. § 103(a)

In the office action, claims 1-27 were rejected under 35 U.S.C. § 103(a) as unpatentable over LaJoie in view of Pal. Applicants respectfully traverse these rejections.

As noted in the Office Action, p. 3 - 4, LaJoie does not disclose or suggest this limitation of assigning a computing device to a particular user only. Indeed, as noted by Applicants previously, LaJoie teaches the use of a *single* “headend unit,” or server computing device which communicates with and provides distributed services to a plurality of user set-top terminals. (*See* LaJoie, col. 9, lines 43-52). In this sense, Lajoie teaches away from the claimed invention.

In fact, as Applicants noted in response to the previous Office Action, the use of a central host to provide all menuing functions and program content as described by LaJoie is precisely the kind of prior art which is discussed in the “Background of the Invention” portion of the application, and would operate subject to the associated drawbacks which the claimed invention is designed to alleviate (e.g., slow system performance due to heavy traffic load on a single host unit). (*See* Response of September 30, 2002, *citing* Specification, p. 2). According to the Court of Appeals for the Federal Circuit, the failure of others to solve a problem which is addressed by the patented invention is “compelling objective evidence of the nonobviousness of the claimed invention.” *In re Hayes Microcomputer Prods., Inc. Patent Litigation (Ven-Tel, Inc. v.*

Hayes Microcomputer Prods., Inc.), 982 F.2d 1527, 1540, 25 U.S.P.Q.2d 1241 (Fed. Cir. 1992).

Pal also fails to disclose or even remotely suggest at least the above-described limitation which is absent from LaJoie. Pal describes a pledge-based resource allocation system in a client/server environment, wherein resources such as database objects are allocated to clients for a limited time period. (*See* Pal, Abstract). As noted in Pal, the system is used to ensure that a client cannot allocate a resource for so long as to affect other client's use of the resource, and to prevent concurrency problems. (*Id.*). This time-limiting for a client's use of a resource, as described within the context of a database system, is very different from the claimed invention. It cannot be said that Pal teaches, e.g., *assigning an assignable computing device (ACD) to the particular user only*, as required by the claimed invention. An assignable computing device is a device which is defined in the specification of the present invention, and bears little resemblance to the database resources of Pal. Accordingly, neither LaJoie nor Pal, viewed alone or in combination, renders the claimed invention obvious. Applicants respectfully submit that independent claims 1 and 16, and all claims depending therefrom, are in condition for allowance.

Moreover, even assuming *arguendo* that LaJoie or Pal describe one or more elements of the claims, these references are not properly combined. As the Court of Appeals for the Federal Circuit has held:

"It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

In re Oetiker, 24, U.S.P.Q.2d 1443, 1447, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

There is no "reason, suggestion, or motivation" in the prior art such that

one of ordinary skill in the art would make the combinations which form the basis of the rejections under 35 U.S.C. § 103(a) in the Office Action. This combination of elements between non-analogous sources, i.e., interactive cable television systems and database resource allocation systems, is apparently improperly made only with the benefit of hindsight in view of the present application. In much the same way that one seeking to solve a problem of “fastening a hose clamp” would not “reasonably be expected or motivated to look to fasteners for garments” for a solution, it is equally unlikely that one seeking to solve a problem in providing assignable distributed video and computing systems would reasonably look to database resource allocation systems. (*See id.*) Accordingly, because there is no teaching or suggestion towards the cited combination in the prior art, in conformity with the law as recited by the Federal Circuit, these references are not properly combined. Applicants therefore respectfully request that the rejections of claims 1-27 under 35 U.S.C. § 103(a) be withdrawn for at least this additional reason, and submit that these claims are in condition for allowance.

Accordingly, Applicants submit that claims 1 and 16 are in condition for allowance. Additionally, because dependent claims 2-15 and 17-27 contain all of the limitations of the claims on which they depend, Applicants submit that these claims are also in condition for allowance.

CONCLUSION

In view of the foregoing remarks, favorable reconsideration and allowance of claims 1-27 are respectfully solicited. In the event that the application is not deemed in condition for allowance, the examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

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